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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,323	06/09/2006	Takeo Yokawa	1422-0720PUS1	4937
2292 7590 04/09/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER PESELEV, ELLI				
ART UNIT 1623		PAPER NUMBER		
NOTIFICATION DATE 04/09/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/582,323

Applicant(s)

YOKAWA ET AL.

Examiner

Elli Peselev

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 12-24 and 26-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ameliorating or treating an irritable bowel syndrome, does not reasonably provide enablement for preventing a bowel disease, including an inflammatory bowel disease or for treating any bowel disease or any inflammatory bowel disease. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A conclusion of lack of enablement means that, based on the evidence regarding each of the factors below, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

(A) The breadth of the claims.

Claims 12-22 and 26-28 read on preventing an inflammatory bowel disease i.e. administering to a healthy patient galactomannan and/or arabinogalactan and preventing said patient from ever getting an inflammatory bowel disease.

Claims 12, 14, 15, 17-21, 23, 24 and 26-28 also read on treating any bowel disease, which encompasses a cancer of a bowel.

(B) The state of the prior art.

The prevention of bowel disease, including an inflammatory bowel disease, is not known in the art.

(C) The amount of direction provided by the inventor.

The inventor does not disclose whether the prevention is achieved for a period of days, months, years or whether permanent prevention is achieved.

No evidence has been presented directed to prevention of a bowel disease or to the treatment of such bowel diseases as ulcerative colitis, Chron's disease or Beheet disease.

(D) The existence of working examples.

The examples set forth in the specification are directed to treating patients with an irritable bowel syndrome and patients suffering from frequent cramps in the lower abdomen. This is clearly not commensurate with the full scope of the claimed invention.

Claims 12-22 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preamble, the claims read on preventing a bowel disease. However, the claims also read on administering the composition to a patient suffering from bowel disease. It is not clear how a disease can be prevented in a patient suffering from said disease.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Garti et al (U.S. Patent No. 5,847,109).

Garti et al disclosed that "isolated galactomannans of the present invention have been found to be effective in preventing constipation and in regulating bowel movement in mammals" (column 3, lines 17-24). Garti et al further disclose the administration of galactomannans in foods such as ice creams, which contain milk protein. (column 3, lines 57-63).

Claims 12-25 and 27 are rejected under 35 U.S.C. 102(a) as being anticipated by Mehansho et al (U.S. Patent No. 6,706,295).

Mehandho et al disclose that arabinogalactam can be used in preventing constipation (column 2, lines 12-15) and can be used in combination with dairy protein and/or soy protein (column 2, lines 36-45).

Claims 12-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garti et al (U.S. Patent No. 5,847,109) in combination with Mehansho et al (U.S. Patent No. 6,706,295).

Garti et al disclose the use of galactomannan in preventing constipation (column 3). Mehansho et al disclose the use of arabinogalactan in combination with dairy protein or soy protein in preventing constipation (column 2). Therefore, it would have been prima facie obvious to a person having ordinary skill in the art at the time the claimed invention was made to combine galactomannan and arabinogalactan into a single composition for the purpose of preventing constipation.

Applicant's arguments filed January 14, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 8.00-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Jiang can be reached on (571) 272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elli Peselev
/Elli Peselev/
Primary Examiner, Art Unit 1623